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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/549,970 | 04/14/2000 | Ilya Ravkin | 0368-001.30 | 9036 |

7590 04/21/2004

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EXAMINER

TRAN, MY CHAU T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1639

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/549,970 | Applicant(s) RAVKIN ET AL. | |
| | Examiner MY-CHAU T TRAN | Art Unit 1639 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69-86 is/are pending in the application.
- 4a) Of the above claim(s) 80-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 69-79, 85 and 86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/7/03 and 9/25/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/10/03 has been entered.

Status of Claims

1. Claims 69-86 are added by the amendment filed on 9/10/2003.
2. Claims 26-41, and 45-68 are canceled by the amendment filed on 9/10/2003.
3. Claims 42-44 are canceled by the amendment filed on 2/3/03.
4. Claims 1-25 are canceled by the amendment filed on 1/14/02.
5. Claims 69-86 are pending.
6. This application claims priority to two provisional applications. They are 60/129,664 filed 4/15/1999 and 60/170,947 filed 12/15/1999.

Election/Restrictions

7. Applicant's election without traverse of Group I (Claims 69-79, and 85-86) in Paper filed on 1/23/04 is acknowledged.

8. Claims 80-84 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper filed 1/23/04.

9. Claims 69-79, and 85-86 are treated on the merit in this Office Action.

Withdrawn Rejections

10. In view of applicant's cancellation of claims 26-41, and 45-68, the previous rejection under 35 USC 112, first paragraph (new matter) has been withdrawn.

11. In view of applicant's cancellation of claims 26-41, and 45-68, the previous rejections under 35 USC 112, second paragraph, have been withdrawn.

12. In view of applicant's cancellation of claims 26-41, and 45-68, the rejection of claims 26-29, 32, and 41-45 under 35 USC 102(e) as anticipated by Nova et al. US Patent No. 5,741,462 April 1998 has been withdrawn.

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13. In view of applicant's cancellation of claims 26-41, and 45-68, the rejection of claims 26-30, 32-37, 41, 45, 55-61, and 63-68 under 35 USC 102(b) as anticipated by Pirrung et al. (US Patent 5,143,854) has been withdrawn.

14. In view of applicant's cancellation of claims 26-41, and 45-68, the rejection of claims 66-68 under 35 USC 102(b) as anticipated by Lee (US Patent 4,053,433) has been withdrawn.

15. In view of applicant's cancellation of claims 26-41, and 45-68, the rejection of claims 26-29, 32-37, and 41-45 under 35 USC 103(a) as being unpatentable over Nova et al. US Patent No. 5,741,462 April 1998 has been withdrawn.

New Rejections

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

17. Claims 69-73, 75-79, and 85-86 are rejected under 35 U.S.C. 102(e) as being anticipated by Millstein (WO 99/197,11; *filing date of 10/16/1997*).

Millstein discloses a wafer array (a system) (pg. 17, lines 10-18; fig. 4). The wafer array comprises different fibers (carriers) that are bundle and cut to form a wafer array 9pg. 17, lines 19-21). Each fiber comprises array members such as cells (pg. 11, line 18 to pg. 12, line 5). The fibers comprise material such as glass or plastic (pg. 19, line 18 to pg. 20, line 36). The array comprises a detector that acquires an image of the array and processing the image qualitatively and quantitatively (pg. 33, lines 28-32). The images are captured in a digitized, computer readable form (mask) (pg. 35, lines 21-35). Therefore, the wafer array of Millstein anticipates the presently claimed system.

18. Claims 69-79, and 85-86 are rejected under 35 U.S.C. 102(e) as being anticipated by Bawendi et al. (US Patent 6,326,144 B1).

Bawendi et al. disclose an immunoassay system (col. 12, lines 27-39; fig. 2). The system comprises a substrate (an examination site), a plurality of nanocrystals (carriers, refers to claim 74), and an imaging apparatus (col. 15, lines 36-38). The nanocrystals are associated with

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biological compounds such as cells (col. 9, lines 37-40; col. 10, lines 1-21). The imaging apparatus produces a set of images of the same spatial region, each colored to a particular wavelength, which would provide information for rapid analysis of the data. Thus, the system of Bawendi et al. anticipates the presently claimed system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on Mon.: 8:00-2:30; Tues.-Thurs.: 7:30-5:00; Fri.: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW WANG can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct
April 19, 2004


PADMASHRI PONNALURI
PRIMARY EXAMINER